

### ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-51 remain in this application.

Claims 1-5, 20-23, 27, 30-34, 44-47, and 51 were rejected under 35 U.S.C. §102(e) as being anticipated by Lockwood (U.S. 6,400,806). Claims 6-12, 15, 18-19, 29, 35-39, 42-43, 50 and 51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lockwood in view of Maes (U.S. 6,073,101). Claims 13-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lockwood in view of Beyda *et al.* (U.S. 6,487,277). Claims 24-26, 28, 48-49, and 51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lockwood. Claims 16-17, 40-41, and 51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lockwood in view of Woods *et al.* (U.S. 6,510,417). For the following reasons, the rejection is respectfully traversed.

Claim 1 recites "uploading means for independently uploading [a] plurality of interactive voice response applications [which provide interactive voice response functionality] through a second telecommunication network by a plurality of independent value-added service providers" wherein "at least a plurality of said plurality of interactive voice response applications uses a common speech recognition module run on said system". Claims 29, 30, and 50 recite similar limitations. Lockwood does not teach these cited claim limitations.

Lockwood does not teach any uploading a plurality of interactive voice response applications. The Examiner cites col. 19, lines 13-30 and col. 20, lines 6-10 as teaching these limitations. However, a close reading of these cited sections of the reference does not support the Examiner's rejection. Col. 19, lines 13-30 discusses storing graphical program information and textual information on prices of

products (lines 14-16). The section further discusses storing order and customer information. However, there is no discussion of downloading any voice response applications.

Likewise, col. 20, lines 6-10 merely discusses accessing sales information. Again, there is no discussion of uploading voice response *applications*. In fact, the reference does not appear to discuss any uploading of computer applications at all. Accordingly, claims 1, 29, 30, and 50 are patentable over the reference.

Further, claim 1 recites that the memory stores a plurality of interactive voice response applications that are uploaded from a *plurality* of service providers. Claim 29 recites similar limitations at lines 5-8. Lockwood does not teach support for a plurality of service provider applications in a single memory. Nor does Lockwood teach "allowing each of a plurality of value-added service providers to set up an interactive voice response application" as recited in claim 30. Accordingly, for these reasons as well, claims 1, 29, 30, and 50 are patentable over the reference.

Furthermore, claim 29 recites that "said common speech recognition module comprises a common user profile database including user preferences". Claim 50 recites similar limitations.

The Examiner cites Lockwood Fig. 12, element 223 as teaching such user preferences. However, item 223 is merely labeled "Customer, product, Account, Files". In addition, this item is described as the "memory 223 stores graphical program information, management of the audiovisual sources and textual information on prices of products and services acquired from the providers, which are periodically updated from the terminals 204 of the various companies, and information on customer requests and orders which can be accessed periodically by the respective providers" (col. 19, lines 14-21). There is no teaching at all of storing user preferences.

Accordingly, for this reason as well, claims 29 and 50 are patentable over Lockwood.

None of Maes, Beyda, or Woods overcomes the Lockwood shortcomings discussed above, and thus claims 1, 29, 30, and 50 are also patentable over any combination of these references. The remaining claims, which depend, directly or indirectly, upon one or more of claims 1, 29, 30, and 50, and patentable over the references for at least the same reasons as their parent claims.

Furthermore, the Examiner has again not provided the proper motivation for combining the references, or making the suggested modifications. Merely stating that the references are analogous, and providing some generalized benefit provided by the teachings of the secondary reference, is not sufficient for a prima facie case of obviousness; the Examiner must provide some more specific motivation for modifying the prior art reference to include that element.

The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination. Instead, the Examiner merely listed an advantage/benefit of the combination. This is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a *convincing line of reasoning* based on *established scientific principles* practiced by one skilled in the art that the advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness are not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33226.

Respectfully submitted,

PEARNE & GORDON, LLP

By

  
Robert F. Bodi, Reg. No. 48,540

1801 East 9<sup>th</sup> Street, Ste. 1200  
Cleveland, Ohio 44114-3108  
(216) 579-1700

July 20, 2005